

REMARKS

This paper is being presented in response to the non-final official action dated November 14, 2007, wherein: **(a)** claims 1, 2, 4-20, 23-39, and 41-54 are pending; **(b)** claims 7, 13, 18, 26, 32 and 37 have been rejected under 35 USC § 112, ¶ 1, as lacking written description; **(c)** claims 1-13, 16-20, 22-32, 35-39, and 41-54 have been rejected under 35 USC § 103(a) as being obvious over Mitra U.S. Patent No. 6,534,457 or Hayward et al. U.S. Patent No. 6,534,456 in view of Lavaud U.S. Patent No. 5,914,117; and, **(d)** claims 14, 15, 33, and 34 have been rejected under § 103(a) as being obvious over the Mitra or Hayward patents in view of the Lavaud patent and further in view of Williams et al. U.S. Patent No. 6,429,177. Reconsideration and withdrawal of the rejections are respectfully requested in view of the foregoing amendments and following remarks.

This paper is timely filed as it is accompanied by a petition under 37 CFR § 1.136(a) for an extension of time to file in the first month, and payment of the required extension fee.

I. Summary of the Amendments

A. Amendments to the Specification

The specification has been amended to expressly incorporate disclosure that was present in the claims as originally filed. Specifically, the paragraph beginning at page 13, line 5, has been amended to state: "In an embodiment, the benefit phase is substantially free of surfactants." Written description support for this amendment can be found in the application as originally filed in, for example, dependent claim 7, which further defined the composition recited in independent claim 1 by specifying that "the benefit phase is substantially free of surfactant." See, e.g., MPEP § 608.01(l) (8th Ed., Rev. 5, Aug. 2006) ("In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it."). The amendment to the specification, therefore, renders moot the § 112, ¶ 1, rejections of claims 7 and 26. See Section II.B.1, below.

The paragraph beginning at page 20, line 3, has been amended to state: "An example of an optional ingredient is a cationic deposition polymer." Written description support for this amendment can be found in the application as originally filed in, for example, dependent claim 18, which further defined the composition recited in independent claim 1 by specifying that the "composition further comprises a cationic deposition polymer." See, e.g., MPEP § 608.01(l). The amendment to the specification, therefore, renders moot the § 112, ¶ 1, rejections of claims 18 and 37. See Section II.B.3, below.

B. Amendments to the Claims

Each of independent claims 1 and 2 has been amended to incorporate the features recited in dependent claims 6 and 25, respectively. Specifically, each of independent claims 1 and 2 has been amended to recite that the benefit phase is substantially anhydrous. Written description support for this amendment can be found in claims 6 and 26 and in the specification at, for example, in the paragraph beginning at page 13, line 5, which states that the "separate benefit phase in the present invention is preferably anhydrous," and in each of the examples, which specify that no water is present in the benefit phase. Dependent claims 6 and 25 have been canceled, without prejudice.

Each of dependent claims 13 and 32 has been amended to recite that the cleansing phase of the claimed composition contains "about 1% to about 50%, by weight of said cleansing phase, of total active surfactant." Written description support for these amendments can be found in the specification at, for example, page 5, lines 21-25.

The foregoing amendments *do not* introduce new matter into the application or into the claims. Importantly, the claim amendments *do not* necessitate a new search and, therefore, any further action rejecting the claims on newly cited prior art may not be made final. See MPEP § 706.07(a) (8th ed., Rev. 6, Sept. 2007) (stating that a "second or any subsequent action on the merits in any application ... should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed").

II. The 35 USC § 112, ¶ 1, Rejections

Claims 7, 13, 18, 26, 32 and 37 have been rejected as allegedly failing to comply with the written description requirement of 35 USC § 112, ¶ 1. See the Action at 2. A response to the rejections is set forth below.

A. Proper Basis for a § 112, ¶ 1, Written Description Rejection

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail such that a person having ordinary skill in the art, as of the specification's effective filing date, could have reasonably concluded that the patent applicants had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003). Patent applicants show possession of the claimed invention by providing a specification describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). While there is no *in haec verba* requirement, amended claims must be supported in the specification through express, implicit, or inherent disclosure.

Amended claims that introduce subject matter not supported by the filed specification, of course, violate the written description requirement. See, e.g., *In re Lukach*, 442 F.2d 967 (CCPA 1971). The fundamental inquiry, however, is whether the filed specification conveys with reasonable clarity to those having ordinary skill in the art that, as of the specification's filing date, the applicants were in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

As set forth in MPEP § 2163(II)(A) (8th ed. Rev. 6, Sept. 2007), the Patent Office bears the burden, after a thorough reading and evaluation of the content of the application, of presenting preponderant evidence of why a person having ordinary skill in the art would not recognize a description of the claimed invention in the specification. *In re Werthein*, 541 F.2d 257, 263 (CCPA 1976). There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed. See *id.* at 262; see also, MPEP § 2163. The rejection of an original claim for lack of written description should be rare.

In rejecting a claim, the Patent Office must set forth express findings of fact identifying the claim limitation at issue, and establishing a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the applicants were in possession of the invention as claimed in view of the disclosure of the application as filed. A general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description. The foregoing standards are set forth in more detail in "Guidelines for Examination of Patent Applications under 35 USC § 112, first paragraph, 'Written Description' Requirement," 66 Fed. Reg. 1099, 1105 (Jan. 5, 2001), and were adopted by the Court of Appeals for the Federal Circuit in 2002. See *Enzo Biochem Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 964 (Fed. Cir. 2002).

B. The Specification Sufficiently Describes the Claimed Invention, and, therefore, the § 112 Rejections Are Traversed and/or Moot

1. The Rejection of Claims 7 and 26 Is Traversed and Moot

Dependent claims 7 and 26 specify that the benefit phase is "substantially free of surfactants." The action asserts that support for this limitation, and specifically the quoted phrase, is not found in the application and, therefore, these claims are not supported by a written description pursuant to § 112, ¶ 1.

The rejection is traversed. Claim 7 is an original claim presented with the application when the application was filed. The application defines the term "substantially free," as less than about 5% of the stated ingredient, and provides preferences for narrower ranges:

The phrase "substantially free of" as used herein, unless otherwise specified means that the composition comprises less than about 5%, preferably less than about 3%,

more preferably less than about 1% and most preferably less than about 0.1% of the stated ingredient.

The Application at page 4, lines 18-20. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as *filed*, see *Werthein*, 541 F.2d at 262, and the Patent Office has not demonstrated that the application lacks such a description. Accordingly, the applicants respectfully submit that the filed application reasonably demonstrates that the applicants possessed the invention recited in rejected claims 7 and 26. A person having ordinary skill in the art could have reasonably concluded as much because that person would have readily understood the definition of the phrase "substantially free" and would have readily understood that original claim 7 specifies that the benefit phase is "substantially free of surfactants." The Patent Office also has not demonstrated that a person having ordinary skill in the art, as of the application's filing date, could have reasonably concluded that the patent applicants lacked possession of the claimed invention. See, e.g., *Moba*, 325 F.3d at 1319.

The application discloses nine examples, each of which describes a multi-phase composition containing a benefit phase. None of the nine examples describes a composition with a benefit phase containing a surfactant. Not only have the applicants demonstrated that they possessed the claimed invention when they filed the application, thereby complying with the written description requirement, the applicants also have enabled persons skilled in the art to make and use the claimed invention. In particular, the applicants provided nine example compositions each with a benefit phase free of surfactant, and the applicants specifically teach how to make the surfactant-free benefit phase of these compositions, at page 23, line 26 through page 28, line 10. The applicants, therefore, have not only provided numerous examples of the presently claimed invention, but also instructions to persons skilled in the art on how to make the surfactant-free benefit phase of the claimed composition.

It does not matter that the specification of the filed application did not specifically state the phrase "substantially free of surfactants." It is settled law that a claim term does not have to be recited *in haec verba* in the specification; support for a claim limitation can be express, implicit, or inherent. The filed application need only demonstrate that the applicants' disclosure has conveyed sufficient information to those skilled in the art that the applicants have invented the claimed subject matter. The applicants have met this burden by their disclosure of Examples 1-9. See MPEP § 2163 (stating that "it is now well accepted that a satisfactory description may be in the claims *or in any other portion* of the originally filed specification" (emphasis added)).

The action's assertion—that the term "substantially free surfactants" is not "located in the applicant's specification"—is not relevant to an inquiry whether the application provides a written description of the claimed invention. The Court of Appeals for the Federal Circuit and

the Court of Customs and Patent Appeals have repeatedly stated that the policy underlying the written description requirement is satisfied when the application clearly conveys to those skilled in the art information demonstrating that the applicants invented the claimed subject matter:

[O]ur predecessor court said in [*In re Smith*, 481 F.2d 910, 914 (CCPA 1973) (emphasis in original)]:

The specification as originally filed must convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. *In re Ruschig*, supra, 54 CCPA [1551] at 1559, 379 F.2d [990] at 996, 154 USPQ [118] at 123. When the original specification accomplishes that, regardless of *how* it accomplishes it, the essential goal of the description is realized.

In deciding the issue, the specification as a whole must be considered.

As also pointed out in *Smith* and as admitted by the board, "the claimed subject matter need not be described in *haec verba* in the specification in order for the specification to satisfy the description requirement." The fact, therefore, that the exact words here in question, "not permanently fixed", are not in the specification is not important. From the wording of the examiner's rejection it would seem that he did not know that; at least he wanted to be shown an "unequivocal teaching" that the microcapsules are not permanently fixed."

* * * *

All of this convinces us that it is of the essence of the original disclosure that the microcapsules are "not permanently fixed" to their various supports. The examiner was therefore wrong in his underlying premise that the limitation added to the claim by amendment contained "new matter". The specification does unequivocally teach the absence of permanently fixed microcapsules. The §112 rejection was clearly erroneous and cannot stand. There is clear compliance with the description requirement."

In re Wright, 866 F.2d 422, 424-25 (Fed. Cir. 1989). Therefore, considering the present specification as a whole, particularly in light of the information disclosed in the examples, the applicants have adequately informed those skilled in the art that the composition may contain a benefit phase that is substantially free of surfactants. Accordingly, the applicants respectfully traverse the rejection of claims 7 and 26, and respectfully request reconsideration and withdrawal of the rejection of those claims. The applicants also respectfully submit that the rejection is moot in view of the amendment to the specification. See Section I, above.

2. The Rejection of Claims 13 and 32 Is Moot

Each of dependent claims 13 and 32 has been amended to recite that the cleansing phase of the claimed composition contains "about 1% to about 50%, by weight of said cleansing phase, of total active surfactant." Written description support for these amendments can be found in the specification at, for example, page 5, lines 21-25. In view of these amendments, the rejection of these claims as allegedly lacking adequate written description in the specification is now moot. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection of these claims.

3. The Rejection of Claims 18 and 37 Is Traversed and Moot

Dependent claims 18 and 37 specify that the composition "further comprises a cationic deposition polymer." The action asserts that this limitation is not found in the application and, therefore, these claims are not supported by a written description pursuant to § 112, ¶ 1:

Claims 18 and 37 state the component "cationic polymer". The examiner asserts that applicant's disclosure does not support the inclusion of any cationic polymer in any proportion. It is noted that applicant does include specific cationic polymers in the examples in specific proportions; however, it appears that the aforementioned claims are not supported for every cationic polymer in any proportions.

The Action at 2-3. The action identifies no legal authority supporting the action's assertion that the applicants must describe "every cationic polymer in any proportions," and the applicants are not aware of any such authority.

The rejection is traversed. Claim 18 is an original claim presented with the application when the application was filed. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as *filed*, see *Werthein*, 541 F.2d at 262, and the Patent Office has not demonstrated that the application lacks such a description. Accordingly, the applicants respectfully submit that the filed application reasonably demonstrates that the applicants possessed the invention recited in rejected claims 18 and 37. A person having ordinary skill in the art could have reasonably concluded as much because that person would have readily understood that original claim 18 specifies that the composition "further comprises a cationic deposition polymer." The Patent Office has not demonstrated that a person having ordinary skill in the art, as of the application's filing date, could have reasonably concluded that the patent applicants lacked possession of the claimed invention. See, e.g., *Moba*, 325 F.3d at 1319.

Examples 1, 2, 4, and 5 of the application disclose compositions containing a cationic deposition polymer:

Ex.	Cationic Deposition Polymer(s)
1	Guar Hydroxypropyltrimonium Chloride (Jaguar C-17 from Rhodia), and Polyquaternium 10 (UCARE polymer JR-30M from Amerchol)
2	Polymethacrylamidopropyltrimonium Chloride (Polycare 133 from Rhodia), and Polyquaternium-39 (Merqurt Plus 3300 from Calgon)
4	Polyquaternium 10 (UCare KG-30M) Jaguar C-17 (from Rhodia)
5	Guar Hydroxypropyltrimonium Chloride (N-Hance 3196 from Aqualon)

See Tables 1 and 2 of the Application. Not only have the applicants demonstrated that they possessed the claimed invention when they filed the application, thereby complying with the written description requirement, the applicants also have enabled persons skilled in the art to make and use the claimed invention. In particular, the applicants provided four example compositions containing cationic deposition polymers, and the applicants specifically teach how to make compositions containing these polymers. The applicants, therefore, have not only provided numerous examples of the presently claimed invention, but also instructions to persons skilled in the art on how to make the claimed composition. See *Wright*, 866 F.2d at 424-25; see also, MPEP § 2163 (stating that “it is now well accepted that a satisfactory description may be in the claims *or in any other portion* of the originally filed specification” (emphasis added)).

Considering the filed application as a whole, the applicants have adequately informed those skilled in the art that the composition may include a cationic deposition polymer. Accordingly, the applicants respectfully traverse the rejection of claims 18 and 37, and respectfully request reconsideration and withdrawal of the rejection of those claims. The applicants also respectfully submit that the rejection is moot in view of the amendment to the specification. See Section I, above.

III. The 35 USC § 103(a) Rejections

Claims 1-13, 16-20, 22-32, 35-39 and 41-54 have been rejected under 35 USC § 103(a) as being obvious over Mitra U.S. Patent No. 6,534,457 or Hayward et al. U.S. Patent No. 6,534,456 in view of Lavaud U.S. Patent No. 5,914,117. Claims 14, 15, 33, and 34 have been rejected under § 103(a) as being obvious over the Mitra or Hayward patents in view of the Lavaud patent and further in view of Williams et al. U.S. Patent No. 6,429,177. See the Action at 3-7.

The Mitra, Hayward, and Williams patents have been discussed in prior communications to and from the Patent Office in connection with prior (and since-withdrawn) rejections under § 103(a). Specifically, the pending claims were previously rejected under § 103(a) over combinations of these patents in an official action dated February 2, 2006. In response to that rejection, the applicants amended the then-rejected independent claims to affirmatively recite the presence of a “density modifier comprising a low density microsphere,” arguing that the combinations of these patents did not disclose the density modifier and, therefore, those combinations could not render the claimed invention obvious. See “Amendment After 1st Office Action Under 37 CFR § 1.111(c),” filed July 28, 2006. The non-final action responsive to the applicants’ amendment and argument *withdrew* the obviousness rejections over the combinations of these patents “in view of applicant’s [sic, applicants’] amendment.” See Official Action dated September 27, 2006, at 2. Indeed, the current action

acknowledges that none of these patents "specifically teach with sufficient specificity applicant's [sic, applicants'] density of the benefit phase," and none discloses "with sufficient specificity applicant's [sic, applicants'] low density microsphere." The Action at 5.

Since the July 28, 2006, amendments and the September 27, 2006, action, the independent claims have not been further amended. Accordingly, the present obviousness rejections appear to be premised almost exclusively on the Patent Office's position that the newly-cited Lavaud patent discloses the "density modifier comprising a low density microsphere" recited in the rejected independent claims, and that a person having ordinary skill in the art would have had an apparent reason to combine that specific disclosure in the Lavaud patent with the teachings set forth in the Mitra, Hayward, and Williams patents to arrive at the applicants' claimed invention:

It would have been obvious to one of ordinary skill in the art to include the microspheres of Lavaud to the compositions of Mitra or Hayward et al because Lavaud teaches low density modifier in skin cleansing formulations and the skilled artisan would have been motivated to include said low density particles to aid as an exfoliant or to enhance the gel formulations for increase delayed reactions. Accordingly, in the absence of a showing to the contrary, one skilled in the art would have been motivated to combine the references for their intended purposes.

The Action at 6. The applicants respectfully submit that the action has not demonstrated that the rejected claims are *prima facie* obvious. The applicants also respectfully submit that the subject matter recited in the rejected claims is not obvious over the combined disclosures of the applied prior art. The rejections are therefore traversed. A complete response to the obviousness rejections is set forth below.

A. Proper Basis for a § 103(a) Rejection

The patent statute states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 USC § 103(a). A determination that a claimed invention is obvious under § 103(a) is a legal conclusion involving four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Secondary considerations of non-obviousness include factors such as commercial success, long-felt but unresolved needs, the failure of others, and/or unexpected results achieved by the claimed invention. *Id.* Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the claimed subject matter pertains, who is presumed to have all prior art references in

the field of the invention available to him/her. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Furthermore, obviousness must be determined as of the time the invention was made and in view of the state of the art that existed at that time. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050-51 (Fed. Cir. 1988).

The Patent Office “has the burden under § 103 to establish a prima facie case of obviousness.” *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); MPEP § 2142 (8th Ed., Rev. 6, Sept. 2007) (“The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.”). The Supreme Court recently identified a number of rationales that may be used to support a conclusion of obviousness, consistent with the framework set forth in its decision in *Graham v. John Deere Co.* See *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739-40 (2007). These and other representative rationales are described at MPEP § 2143 (8th Ed., Rev. 6, Sept. 2007). Regardless of the supporting rationale, however, the Patent Office must clearly articulate facts and reasons why the claimed invention “as a whole” would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s effective filing date. See *KSR Int’l*, 127 S.Ct. at 1741 (citing with approval *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)); see also MPEP § 2143 (“The key to supporting any rejection under 35 USC § 103 is the clear articulation of reason(s) why the claimed invention would have been obvious.”).

B. The § 103(a) Rejections Are Traversed

The action does not clearly articulate facts and reasons why the claimed invention as a whole would have been obvious to a hypothetical person having ordinary skill in the art at least as of the claimed invention’s effective filing date. Specifically, the action does not articulate accurate findings of fact relating to the scope and content of the prior art, and does not fairly acknowledge the differences between the claimed invention and the prior art. The action supports the § 103 rejection of the pending claims by the rationale that the skilled artisan would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success. While the action appears to rationalize its conclusion of obviousness, the action does not articulate facts sufficient to support the asserted rationale. See MPEP § 2143. The action, therefore, does not set forth a prima facie case of obviousness. Accordingly, the applicants respectfully traverse the rejections, and request reconsideration and withdrawal of the rejection.

1. The Mitra and Hayward Patents Are Not Properly Combinable with the Lavaud Patent

The claimed invention is directed to a multi-phase cleansing composition having improved stability. See the Application at p. 1, lines 12-14. This improved stability is especially desirable in compositions where the cleansing and benefit phases are in physical contact with one another and are expected to remain in such contact, yet also maintain their distinctness, over a prolonged period of time. See generally, *id.* at p. 1, line 26, to p. 2, line 8. The inventors have disclosed and claimed an invention wherein this stability is attainable without compromising the cleansing and benefit properties of the distinct phases. Specifically, the inventors teach that this stability can be attained by modifying the densities of the separate phases, such that they are equal to one another, preferably with low density microspheres:

To further improve stability under stress conditions such as high temperature and vibration, it is preferable to adjust the densities of the separate phases such that they are substantially equal. To achieve this, low density microspheres are added to the cleansing phase of the striped composition. The low density microspheres employed to reduce the overall density of the cleansing phase are particles having a density lower than 0.7 g/cm³, preferably less than 0.2 g/cm³, more preferably less than 0.1 g/cm³, most preferably less than 0.05 g/cm³.

* * * *

Just as low density microspheres can be added to the cleansing phase of the present invention to improve vibrational stability, high density materials can be added to the benefit phase to increase its density having the same impact on stability.

See *id.* at p. 8, lines 26-32, and p. 9, lines 25-27. Consistent with these teachings, the rejected independent claims recite the presence of a "density modifier comprising a low density microsphere." See claims 1 and 2. Various dependent claims further define this density modifier. See, e.g., claims 4, 5, 23, 24, 41-46, and 51-54.

The Lavaud patent teaches the use of hollow particles; however, that teaching has nothing to do with maintaining the stability of distinct phases of a multi-phase composition. Instead, the Lavaud patent teaches that the hollow particles, in combination with a specific monoester, provide a delayed-foaming, cosmetic composition having "appropriate rheology, i.e., rigidity and consistency." See the Lavaud patent at col. 1, lines 41-49. The Lavaud patent exemplifies the use of these hollow particles and the monoester in the manufacture of a shaving gel (Example 1), a shaving cream (Example 2), a shaving foam (Example 3), and a deodorant stick (Example 4). *Id.* at col. 6, line 15, to col. 8, line 12. The Lavaud patent does not teach that the hollow particles disclosed therein can be useful for anything other than improving the rheology of a delayed-foaming composition. The Mitra and Hayward patents are not directed to delayed-foaming compositions.

The action does not articulate accurate findings that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the Mitra or Hayward patents' teachings or to combine those teachings with selected teachings in the Lavaud patent. According to the action, "Lavaud teaches low density modifier in skin cleansing formulations and the skilled artisan would have been motivated to include said low density particles to aid as an exfoliant or to enhance the gel formulations for increase delayed reactions." The action identifies no support for such a statement or conclusion. None of the Mitra and the Hayward patents extols the virtues of exfoliants or increased delayed reactions. Mitra and Hayward et al. state that exfoliants such as polyoxyethylene beads, walnut sheets, and apricot seeds may be optional ingredients in a multi-phase composition. The Mitra patent at col. 11, lines 11-15; The Hayward patent at col. 10, lines 34-38. That is the only mention of exfoliants in either of those patents. The applicants can find nothing in the Lavaud patent mentioning the desirability of exfoliants. Furthermore, the applicants can find nothing in the Mitra and the Hayward patents mentioning any desirability of delayed reactions. The applicants respectfully submit that the record evidence does not demonstrate that a person having ordinary skill in the art would have any apparent reason to select the hollow spheres disclosed in the Lavaud patent for combination with the teachings set forth in the Mitra or Hayward patents. The asserted rationale supporting the § 103(a) rejections does not apply, however, absent findings that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See MPEP § 2143 (G). Moreover, the mere fact that the applied prior art can be combined does not render the resultant combination obvious unless the results would have been predictable to the ordinarily skilled artisan. See *KSR Int'l*, 127 S.Ct. at 1740.

Accordingly, on this basis alone, the § 103(a) rejections are traversed, and reconsideration and withdrawal of the rejection are respectfully requested.

2. The Mitra and Hayward Patents Teach Multi-Phase Compositions wherein Each Phase Requires Substantial Amounts of Water

The claimed invention (as amended herein) is not rendered obvious by the applied prior art because the primary references (the Mitra and Hayward patents) do not teach a "substantially anhydrous" benefit phase of a multi-phase composition, as recited in each of the pending claims. To the contrary, all of the examples in each of the Mitra and Hayward patents specify the presence of substantial amounts of water in each of the phases. There is nothing in these patents that suggests that the volume of water may be reduced to as little as 10%, or omitted altogether, in any of these phases. Nothing in the secondary references

suggests this either. Consequently, the applied prior art taken as a whole and together do not render the claimed invention obvious.

Accordingly, on this basis alone, the § 103(a) rejections are traversed, and reconsideration and withdrawal of the rejection are respectfully requested.

3. The Williams Patent Teaches Away from the Claimed Invention

The § 103(a) rejection of claims 14, 15, 33, and 34 over the Mitra or Hayward patents in view of the Lavaud patent and further in view of Williams et al. U.S. Patent No. 6,429,177 is additionally traversed because the Williams patent teaches away from the claimed subject matter. See *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003) (stating that evidence useful to rebut any *prima facie* evidence of obviousness can include "evidence that the prior art teaches away from the claimed invention in any material respect").

Specifically, the Williams patent teaches that the multi-phase composition disclosed therein has a lower layer having a density that is greater than the upper layer:

The compositions of the invention, when unmixed, have a viscosity of the lower layer which is lower than the viscosity of the upper layer and *a density of the lower layer which is greater than the density of the upper layer*.

The Williams patent at col. 10, lines 48-51 (emphasis supplied); see also, *id.* at col. 13, lines 60-62 (specifying a multi-phase composition having an upper phase with a density of 1.0992 g/cm³ and a lower phase with a density of 1.2656 g/cm³). This teaching directly contradicts the present application's teachings that desirable stability can be attained by modifying the densities of the separate phases, such that they are equal to one another. See generally, the Application at p. 8, lines 26-32, and p. 9, lines 25-27. The present application specifically teaches the skilled artisan a composition wherein the two phases of the composition have the same densities. Moreover, the claimed invention specifies that the two phases have substantially the same density. See, e.g., claims 1 and 2.

Furthermore, the Williams patent teaches compositions that either lack an oily phase, and/or contain substantial amounts of water:

It is important to emphasize that at least two of the distinct phases are aqueous solutions and that the composition can be prepared without any oil if desired.

Id. at col. 4, lines 20-22; see also, Tables 2-4 of the Williams patent at cols. 13 and 14 (specifying the presence of substantial amounts of water). These teachings also are contrary to the teachings in the present application and pending claims, which specify that the benefit phase is substantially anhydrous.

The applicants have, thus, identified evidence in the Williams patent that Williams et al. teach away from the applicants' claimed invention. The Patent Office must consider such evidence supporting patentability. See, e.g., *In re Sullivan*, 498 F.3d 1345, 1352-53 (Fed. Cir.

2007) (reversing a Patent Office decision of obviousness because the Patent Office failed to consider the applicants’ evidence rebutting a prima facie case of obviousness). If the Patent Office determines that such evidence is not compelling or is insufficient, then the Patent Office should specifically set forth the facts and reasoning supporting that determination. MPEP § 2145 (8th Ed., Rev. 6, Sept. 2007).

Accordingly, on the basis that the Williams patent teaches away from the claimed invention, the § 103(a) rejections are traversed, and reconsideration and withdrawal of the rejection are respectfully requested.

C. Conclusion

In view of the foregoing, the applicants respectfully traverse the § 103 rejections and submit that the claimed invention is unobvious. The applicants, therefore, request reconsideration and withdrawal of the rejections.

Prima facie obviousness under § 103 is a legal conclusion—not a fact—based on underlying facts. *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976); *In re Kumar*, 418 F.3d 1361, 1365 (Fed. Cir. 2005) (“Determination of obviousness under 35 USC § 103 is a legal conclusion based on underlying facts.”). The foregoing response identifies facts (e.g., evidence in the form of statements or omissions in the applied prior art) rebutting the alleged legal conclusion that the claimed invention is prima facie obvious. All of these facts must be evaluated along with the facts on which the legal conclusion was originally reached—not the legal conclusion itself. Having requested herein reconsideration of the legal conclusion set forth in the official action, the Patent Office is obligated to address all of the evidence and base its forthcoming legal conclusion(s) on such evidence, uninfluenced by its earlier conclusions. *Rinehart*, 531 F.2d at 1052.

CONCLUSION

In view of the foregoing, the applicants respectfully request entry of the amendments to the specification and to claims 1, 2, 13, and 32, cancellation of claims 6 and 25, reconsideration and withdrawal of the rejections, and allowance of all pending claims.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, the examiner is urged to contact the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

March 13, 2008

/ Sandip H. Patel #43,848/

Sandip H. Patel (Reg. No. 43,848)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
Telephone: (312) 474-6300